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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Osamu MIZUNO et al. : **Mail Stop: PCT**
Serial No. 10/579,776 : Attorney Docket No. 2006_0764A
Filed May 18, 2006 :

OPTICAL DISC APPARATUS
[Corresponding to PCT/JP2004/017948
Filed December 2, 2004]

**SUBMISSION OF ENGLISH VERSIONS OF INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY AND WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith for consideration by the Examiner are:

- 1) An English version of the International Preliminary Report on Patentability; and
- 2) An English version of the Written Opinion of the International Searching

Authority.

Respectfully submitted,

Osamu MIZUNO et al.

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December 11, 2006

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

To:

KAWAMIYA, Osamu
AOYAMA & PARTNERS, IMP Building, 3-7, Shiromi
1-chome, Chuo-ku, Osaka-shi, Osaka
5400001
JAPON



Date of mailing (day/month/year)
03 August 2006 (03.08.2006)

Applicant's or agent's file reference
664713

International application No.
PCT/JP2004/017948

International filing date (day/month/year)
02 December 2004 (02.12.2004)

Applicant

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD. et al

IMPORTANT NOTIFICATION**1. Transmittal of the translation to the applicant.**

The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Facsimile No. +41 22 338 82 70

Form PCT/IB/338 (January 2004)

Authorized officer

Yoshiko Kuwahara

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外国方式

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 664713	FOR FURTHER ACTION		See item 4 below
International application No. PCT/JP2004/017948	International filing date (<i>day/month/year</i>) 02 December 2004 (02.12.2004)	Priority date (<i>day/month/year</i>) 03 December 2003 (03.12.2003)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input checked="" type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input checked="" type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70	Date of issuance of this report 27 July 2006 (27.07.2006) Authorized officer <div style="text-align: center; font-weight: bold; font-size: 1.2em;">Yoshiko Kuwahara</div> e-mail: pt07@wipo.int
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PATENT COOPERATION TREATY

TRANSLATION

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

664713

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/JP2004/017948

International filing date (day/month/year)

02.12.2004

Priority date (day/month/year)

03.12.2003

International Patent Classification (IPC) or both national classification and IPC

Applicant

MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.

1. This opinion contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the opinion |
| <input type="checkbox"/> | Box No. II | Priority |
| <input checked="" type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input checked="" type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/JP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/017948

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐

This opinion has been established on the basis of a translation from the original language into the following language

_____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐

a sequence listing

☐

table(s) related to the sequence listing

b. format of material

☐

in written format

☐

in computer readable form

c. time of filing/furnishing

☐

contained in the international application as filed.

☐

filed together with the international application in computer readable form.

☐

furnished subsequently to this Authority for the purposes of search.

- 3.

☐

In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/017948

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application

☒ claims Nos. 14, 15

because:

☐ the said international application, or the said claims Nos. _____
relate to the following subject matter which does not require an international preliminary examination (*specify*):

☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 14, 15
are so unclear that no meaningful opinion could be formed (*specify*):

It is unclear what the term "first displacement distance" and "second displacement distance" in claims 14, 15 indicates even in view of the description and the drawings. Further, the effect that the inventions of claims 14, 15 can produce is also not described at all in the description or in the drawings. As a consequence, the technical meaning of the inventions of claims 14, 15 is unclear.

☐ the claims, or said claims Nos. _____ are so inadequately supported
by the description that no meaningful opinion could be formed.

☐ no international search report has been established for said claims Nos. _____

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form

☐ has not been furnished

☐ does not comply with the standard

the computer readable form

☐ has not been furnished

☐ does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.

☐ See Supplemental Box for further details.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/017948

Box No. IV Lack of unity of invention

1. ☐ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has:
- ☐ paid additional fees
 - ☐ paid additional fees under protest
 - ☐ not paid additional fees
2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is
- ☐ complied with
 - ☒ not complied with for the following reasons:

The common feature of the inventions of claims 1-13 is the point that "when focusing servo is not being applied, the objective lens is fixed at a position where the optical lens is not in contact with the optical disk."

However, the search has revealed that the above point is disclosed in [JP, 7-98875, A (Ricoh Co., Ltd.), 11 April, 1995 (11.04.95), [0016] - [0028], Figs. 1-9], so that it is not novel.

As a consequence, there is no feature common to all inventions of claims 1-13, so that it is obvious that the inventions of claims 1-13 do not satisfy the requirement of unity of invention.

4. Consequently, this opinion has been established in respect of the following parts of the international application:

- ☒ all parts
- ☐ the parts relating to claims Nos. _____

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/JP2004/017948

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	5-13	YES
	Claims	1-4	NO
Inventive step (IS)	Claims	5-10	YES
	Claims	1-4, 11-13	NO
Industrial applicability (IA)	Claims	1-13	YES
	Claims		NO
2. Citations and explanations:			
<p>Document 1: JP, 6-301983, A (Matsushita Electric Industrial Co., Ltd.), 28 October, 1994 (28.10.94), [0001] - [0022], Figs. 1-4</p> <p>Document 2: JP, 2001-134954, A (Sony Corp.), 18 May, 2001 (18.05.01), [0001] - [0053], Figs. 1-11</p> <p>Document 3: JP, 2002-373439, A (NEC Corp.), 26 December, 2002 (26.12.02), [0002]</p> <p>Document 4: JP, 5-342585, A (Sharp Corporation), 24 December, 1993 (24.12.93), [0025] - [0056], Figs. 1, 2</p> <p>The inventions of claims 1-4 do not appear to be novel or to involve an inventive step, since they are described at the above mentioned locations of documents 1, 2 cited in the ISR.</p> <p>The point described in claim 11 that "the operating distance of the objective lens is smaller than the vibrational amplitude of the surface runout of the optical disk" is publicly known as stated by the applicant in [0052] of the description of the present application, or as described in [0002] of document 3. As a consequence, it is easy for a person skilled in the art to constitute the optical disk device so that the operating distance of the objective lens is smaller than the vibrational amplitude of the surface runout of the optical disk also in the inventions described in documents 1, 2.</p> <p>The idea described in claim 12 of "setting the distance between the average position of the objective lens side of the optical disk and the front edge position of the objective lens to at least 1/2 of the vibrational amplitude of the surface runout" is described in [0021] or Fig. 2 of document 2.</p> <p>The ideas described in claim 13 that, "during a break", the power of the servo circuit turns OFF, or that the recording/reproduction operation of the optical disk device is interrupted is described at the above mentioned locations of document 3. Therefore, it is easy for a person skilled in the art to let the function that prevents the objective lens from coming into contact with the optical disk also work during the said "breaks" in the inventions of document 1, 2.</p>			